

### REMARKS

Claims 1, 4-12 and 43-51, of which claims 1 and 12 are independent in form, are presented for examination.

The specification has been objected to as failing to provide antecedent basis for the claimed subject matter, in particular, a third layer comprising an oxidized form of an alloy. But this antecedent basis can be found in numerous portions of Applicants' specification. For example, the specification states, "After layer 20 or 26 is formed, stent 10 can be passivated by exposing the stent to an appropriate environment. For example, stent 10 can be oxidized by heating the stent in an oxidizing atmosphere, such as one containing oxygen and/or water, to form an oxide layer on layer 20 or 26." *See* P. 8, ¶ [0049]. Various portions of the specification describe layer 20 as including an alloy of the radiopaque material(s) in the radiopaque layer 18 and one or more alloying materials. *See, e.g.*, p. 6, ¶ [0042]. The specification also explains that the oxide can be formed from the outer layer of the stent. *See, e.g.*, p. 4, ¶¶ [0021] and [0022]. Other antecedent bases can be found in other portions of the specification, so Applicants request that the objection be reconsidered and withdrawn.

Claims 1, 4-12, and 43-51 have been objected to because the preamble allegedly breathes no life into the claims. The basis for this objection is not clear. It appears that the preamble does give meaning the claims because the Examiner has apparently construed that the preamble in these claims, when read in the context of the claims, recites limitations of the claims. Indeed, all the references cited so far are directed to stents. Applicants request that the objection be reconsidered and withdrawn.

Claims 1, 4-12, and 43-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,099,561 (Alt) in view of U.S. Patent No. 6,261,320 (Tam). The Examiner has acknowledged that Alt does not describe a third layer comprising an oxidized form of an alloy, and has relied on Tam for this missing feature. In particular, the Examiner has asserted that Tam teaches stents having gold alloys that are oxidized to help bond the gold to the substrate. *See* Office Action, p. 4.

Applicants have been unable to find where Tam teaches a layer comprising an oxidized form of an alloy comprising a radiopaque material and a second material, as claimed. Rather,

Tam describes using a tie layer between an underlying substrate and an overlying isotope layer. *See* Tam, col. 29, lines 14-47. Tam states that the tie layer (e.g., gold) can alloy with a substrate (e.g., chromium) (*Id.*, lines 23-27), and that the tie layer can be in form of an oxide (*Id.*, lines 29-32). But there is no indication that the alloy (e.g., gold-chromium) of the substrate and the tie layer is oxidized, or that the tie layer in the form of an oxide includes an oxidized form of an alloy comprising a radiopaque material and a second material, as claimed. Indeed, the Examiner has not pointed to any portion of Tam that teaches stents having gold alloys that are oxidized to help bond the gold to the substrate. Thus, Applicants request that the Examiner provide support in Tam for the above assertion.

Moreover, there is no motivation to combine Alt and Tam for at least the reason that Alt already addresses the motivation proposed by the Examiner. The only motivation proposed by the Examiner is that it would have been obvious to take the invention of Alt and oxidize an alloy layer to prevent peeling and shearing. But there is no indication that Alt has a problem with peeling or shearing. On the contrary, Alt expressly states that its alloy layer 50 is formed using processes that preclude cracking, peeling or flaking:

The overall effect of these processes is to provide the adherence that will preclude cracking, peeling or flaking of any portion of the overall gold layer from the underlying surface of the steel core, which would otherwise tend to occur during times when the stent is undergoing mechanical stress and distortion, such as during the pre-opening, crimping, and expansion-during-deployment phases of the procedure.

(*See* Alt, col. 9, lines 36-43.) As a result, one skilled in the art reading Alt would not have been motivated to lengthen the manufacturing process of Alt's stent by oxidizing the alloy layer, particularly when Alt expressly states that cracking, peeling or flaking is precluded. The Examiner's sole motivation to combine Alt and Tam is unsupported by the references and appears to be guided by hindsight reasoning.

For at least the reasons discussed above, Applicants believe the claims are in condition for allowance, which action is requested.

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Serial No. : 10/629,934  
Filed : July 29, 2003  
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Attorney's Docket No.: 10527-410002 / 01-486 (CON)

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

Date: March 2, 2006



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